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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/052,076 | 01/16/2002 | Dan Kikinis | P1553D2 | 3459 |

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EXAMINER

WINDER, PATRICE L

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| ART UNIT | PAPER NUMBER |
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2145

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,076

Applicant(s)

KIKINIS, DAN

Examiner

Patrice Winder

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18, 19 and 21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 16, 18, 19 and 21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

PD

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "host server", does not reasonably provide enablement for "email server". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. By convention, email servers are messaging servers that route and process emails for email systems. A conventional email server is external to applicant's host server. Therefore, one of ordinary skill would not consider the host server of the present invention an "email server".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16, 18-19 and 21 rejected under 35 U.S.C. 102(e) as being anticipated by Wicks et al., USPN 5,796,394 (hereafter referred to as Wicks).

5. Regarding claim 16, Wicks taught a system for delivering emails to a user (abstract), comprising:

a network-connected server for receiving and processing the emails (column 4, lines 1-/-);

a database at the network server for storing user preferences used by the network-connected server for processing the emails (column 5, lines 37-52; column 11, lines 48-58);

a wireless transmission facility in communication with the network-connected server, for transmitting the emails (column 6, lines 42-46); and

a portable playback device enabled for connection to a user computer (column 5, lines 20-31) and receiving the emails transmitted by the transmission facility and to display the emails as text to the user (column 9, lines 22-26);

wherein the email server transmits emails to the user computer for download to the portable device via the network while the device is connected to the user computer (column 9, lines 36-42), and upon disconnection of the portable device from the user computer the wireless transmission facility is instructed by code sent from the user computer to transmit the emails directly to the portable device (column 11, line 59 – column 12, line 14).

6. Regarding dependent claim 18, Wicks taught wherein the network is Internet network (column 4, lines 1-5).

7. Regarding claim 19, Wicks taught a method for delivering multimedia emails to a user, comprising the steps of:

a) receiving the multimedia emails on a network by a network-connected server (column 4, lines 1-8);

b) storing user preferences at a database at the network-connected server (column 5, lines 37-52, column 11, lines 48-58);

c) processing the emails at the network-connected server by accessing the user preferences (column 11, lines 48-58);

d) transmitting individual ones of the emails over the network by the network-connected server (column 6, lines 5-10);

e) receiving the transmitted emails at a user computer for download to a portable playback device connected to the user computer (column 5, lines 37-52), and displaying the emails on a display of the playback device (column 9, lines 34-42); and

f) editing the user preferences via direct communication from the playback device (column 9, lines 11-26);

wherein the network-connected server transmits emails to the user computer for download to the portable device via the network while the device is connected to the user computer (column 9, lines 36-42), and upon disconnection of the portable device from the user computer the network-connected server is instructed by code sent from the user computer to transmit emails directly to the portable device by a wireless transmission facility (column 11, line 59 – column 12, line 14).

8. Regarding dependent claim 21, Wicks taught wherein the network is the Internet (column 4, lines 1-5).

Conclusion

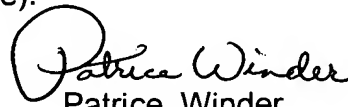
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Thurlow et al., USPN 6,457,879 B1: taught a method for continuously processing electronic messages throughout a transition between online and offline states.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2145

September 30, 2005